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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,506	08/30/2001	Pai-Hung Pan	2919.5US (96-499.2)	4348
24247	7590	12/28/2005	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			FOURSON III, GEORGE R	
			ART UNIT	PAPER NUMBER
			2823	
DATE MAILED: 12/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,506

Applicant(s)

PAN, PAI-HUNG

Examiner

George Fourson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 and 9-12 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8, 13, 18, 19, 21, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) 5, 14, 20 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant argues that 37 C.F.R. § 41.39(a)(2) precludes reopening of prosecution. However, applicant has misinterpreted the rule. The rule merely provides for a course of action the examiner "may" take. See MPEP 706.07(e). Therefore, the reply filed 12/7/05 is considered to be a response to the office action mailed 9/6/05 instead of a reply brief.

Claim 22 is objected to because of the following informalities: In claim 22, it appears that "buffer film layer" should be replaced with - - trench isolation structure - - . Appropriate correction is required.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 8 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 5-12 of prior U.S. Patent No. 6322634. This is a double patenting rejection.

See especially claim 12.

Applicant's arguments have been addressed in the statement of the rejection in the office action mailed 12/7/05.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4,6,13,18,19,21,23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by either one of Morita or Mandelman et al.

Morita discloses in figure 72 trench isolation structure contacting the surface of the active surface area adjacent the trench formed by element 37, including a flat surface, and a portion of element 11 contacting silicon nitride buffer film layer 30 (figure 72).

Mandelman et al discloses in the process step between the intermediate products of figures 4a and 4b trench isolation structure contacting the surface of the active surface area adjacent the trench formed by element 22c, including a flat surface, and a portion of element 11 contacting silicon nitride buffer film layer 12 (figure 72).

Applicant argues that in the structure in fig.72 of Morita the entire surface of the isolation structure is not flat. However, a surface is flat as recited. Further, the claims do not require the surface to be at the

top of the structure. The structure contains several flat surfaces including the bottom and sides of the structure.

Applicant's argument regarding the isolation structure contacting only a certain area of the substrate are addressed in the statement of the rejection in the office action mailed 12/7/05 and repeated hereinafter: "Applicant appears to argue that the references label the isolation structures differently than applicant would label the structures and therefor the isolation structures of Mandelman et al and Morita do not contact the substrate as recited. However, the isolation structures of Mandelman and Morita et al can be labeled as argued above notwithstanding the labels applied by applicant or the disclosures of the references themselves because the structures identified as isolation structures above provide the function of isolation". To further clarify, the portion of layer 11 not covered by element 3(37) is not part of the isolation structure.

Applicant's allegation that the examiner confuses layer 11 with a part of the STI structure is incorrect. There is no discernable boundary between the portion of the isolation structure comprised of the ledge portion of layers 3(37)/11 and the rest of the isolation structure as is required by the claims, notwithstanding applicant's mischaracterization of the claim language.

Applicant argues that the isolation structure of fig.72 is not exposed through a buffer film layer. In response applicant is directed to element 30.

Applicant's arguments regarding the teachings of Mandelman are analogous to those regarding the teachings of Morita and are adequately addressed in the statement of the rejection in the office action mailed 12/7/05 and in the response to the arguments regarding the teachings of Morita above.

Claims 5,14,20 and 22 (see objection above) are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 7-12 are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Fourson whose telephone number is (571) 272-1860. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Smith, can be reached on (571) 272-1907. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'George Fourson', written in a cursive style.

George Fourson
Primary Examiner
Art Unit 2823

GFourson
December 16, 2005